

ESTTA Tracking number: **ESTTA678591**Filing date: **06/17/2015**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

**Opposer Information**

Name	Diageo North America, Inc.		
Entity	Corporation	Citizenship	Connecticut
Address	801 Main Avenue Norwalk, CT 06851 UNITED STATES		

Attorney information	Brian P. O'Donnell Kilpatrick Townsend & Stockton LLP 1400 Wewatta Street, Suite 600 Denver, CO 80202 UNITED STATES denverteas@kilpatricktownsend.com, bodonnell@kilpatricktownsend.com, tdavis@kilpatricktownsend.com Phone:303.571.4000
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**Applicant Information**

Application No	86366388	Publication date	05/19/2015
Opposition Filing Date	06/17/2015	Opposition Period Ends	06/18/2015
Applicant	DESTILERIA COQUI INC PARQUE INDUSTRIAL MARIA LUISA ARCELAY MAYAGUEZ, 00682 PR		

**Goods/Services Affected by Opposition**

Class 033. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Rum
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**Grounds for Opposition**


Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

**Marks Cited by Opposer as Basis for Opposition**


U.S. Registration No.	972985	Application Date	03/06/1972
Registration Date	11/13/1973	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN		
Design Mark			
Description of	NONE		


Mark	
Goods/Services	Class 033. First use: First Use: 1971/12/23 First Use In Commerce: 1971/12/23 RUM

U.S. Registration No.	3466371	Application Date	10/12/2007
Registration Date	07/15/2008	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 032. First use: First Use: 2006/04/01 First Use In Commerce: 2006/04/01 Brewed malt-based alcoholic beverage inthe nature of a beer		

U.S. Registration No.	4705270	Application Date	04/11/2014
Registration Date	03/17/2015	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN 1671		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2014/05/31 First Use In Commerce: 2014/05/31 Alcoholic beverages except beers		

U.S. Registration No.	3159948	Application Date	04/29/2004
Registration Date	10/17/2006	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN		

Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 1982/04/15 First Use In Commerce: 1982/04/15 Alcoholic Beverage, namely, distilled spirits		

U.S. Registration No.	4126073	Application Date	05/14/2010
Registration Date	04/10/2012	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN		
Design Mark			
Description of Mark	The mark consists of the words "CAPTAIN" and "MORGAN" in a stylized font.		
Goods/Services	Class 033. First use: First Use: 2011/11/30 First Use In Commerce: 2011/11/30 Alcoholic beverages except beers		

U.S. Registration No.	4281706	Application Date	01/17/2012
Registration Date	01/29/2013	Foreign Priority Date	NONE
Word Mark	CAPTAIN'S ORDERS!		

Design Mark	CAPTAIN'S ORDERS!
Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2004/01/00 First Use In Commerce: 2004/01/00 Alcoholic beverages except beers

U.S. Registration No.	3435812	Application Date	10/23/2007
Registration Date	05/27/2008	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN TATTOO		
Design Mark	CAPTAIN MORGAN TATTOO		
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2004/06/00 First Use In Commerce: 2004/06/00 Distilled Spirits		

U.S. Registration No.	4290286	Application Date	04/26/2012
Registration Date	02/12/2013	Foreign Priority Date	NONE
Word Mark	CAPTAIN MORGAN BLACK		
Design Mark	CAPTAIN MORGAN BLACK		

Description of Mark	NONE
Goods/Services	Class 033. First use: First Use: 2012/02/15 First Use In Commerce: 2012/02/15 Alcoholic beverages except beers

U.S. Registration No.	4260826	Application Date	04/19/2012
Registration Date	12/18/2012	Foreign Priority Date	NONE

Word Mark	CAPTAIN MORGAN BLACK
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Design Mark	
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Description of Mark	The mark consists of the stylized words "CAPTAIN MORGAN" below which is the word "BLACK" in a stylized font superimposed over a swirl design.
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Goods/Services	Class 033. First use: First Use: 2012/02/15 First Use In Commerce: 2012/02/15 Alcoholic beverages except beers
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U.S. Registration No.	3603578	Application Date	10/22/2007
Registration Date	04/07/2009	Foreign Priority Date	NONE

Word Mark	CAPTAIN MORGAN PARROT BAY
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Design Mark	
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Description of Mark	NONE
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Goods/Services	Class 033. First use: First Use: 2008/08/06 First Use In Commerce: 2008/08/06 Distilled Spirits
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Attachments	77303060#TMSN.png( bytes ) 86249606#TMSN.png( bytes ) 78410544#TMSN.png( bytes ) 85039011#TMSN.png( bytes ) 85518308#TMSN.png( bytes ) 77310869#TMSN.png( bytes ) 85609416#TMSN.png( bytes ) 85602310#TMSN.png( bytes ) 77310152#TMSN.png( bytes ) 60440-947801 Notice of Opposition - CAPTAIN MARY SPICED RUM.pdf(196598 bytes ) 60440-947801 Exhibit A.pdf(4391850 bytes )
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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Brian P. O'Donnell/
Name	Brian P. O'Donnell
Date	06/17/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application Serial No. 86/366,388  
Published in the Official Gazette on May 19, 2015  
Mark: CAPTAIN MARY SPICED RUM  
International Class: 33

DIAGEO NORTH AMERICA, INC.,

Opposer,

-against-

DESTILERIA COQUI INC.,

Applicant.

**NOTICE OF OPPOSITION**

Opposer Diageo North America, Inc. (“Opposer”) will be damaged by the registration of the mark CAPTAIN MARY SPICED RUM (“Applicant’s Mark”) for “rum” in International Class 33, as shown in application Serial No. 86/366,388 and states the following grounds for its opposition to that application:

1. Opposer is a Connecticut corporation with its principal place of business located at 801 Main Avenue, Norwalk, Connecticut 06851.
2. Opposer and its predecessors-in-interest have owned and extensively, exclusively and continuously used inherently distinctive marks consisting of or including CAPTAIN MORGAN and/or CAPTAIN (collectively, “Opposer’s Marks”) in commerce in the United States in connection with alcoholic beverages, including rum, and various other goods since at least as early as 1971 – long before the filing date of the application herein opposed, or any other date upon which Applicant can rely in this proceeding.
3. During its continuous use of Opposer’s Marks, Opposer and its authorized wholesalers, distributors, and retail accounts have expended considerable time, effort and money


in extensively advertising, marketing and publicizing the sale of alcoholic beverages and various other goods bearing Opposer's Marks throughout the United States.



4. During its continuous use of Opposer's Marks, Opposer has directly and indirectly sold, and offered for sale, alcoholic beverages and various other goods bearing Opposer's Marks to wholesalers, distributors, and individuals over the legal purchase age for alcohol throughout the United States.

5. In addition, from a date long prior to any date upon which Applicant can rely in this proceeding, consumers and the public have recognized and commonly used Opposer's Marks to refer to Opposer's goods bearing those marks, and have come to identify Opposer's Marks with Opposer and its goods.

6. As a result of at least the foregoing, Opposer's Marks are strong, famous, and widely recognized by the general consuming public of the United States as a designation of source of Opposer's goods and have been so from a date prior to any date upon which Applicant can rely in this proceeding.

7. In addition to Opposer's extensive common-law rights in Opposer's Marks, Opposer owns numerous registrations and incontestable registrations of marks consisting in part of the word "Captain" for a variety of alcoholic beverages, among other things, including but not limited to the following:

<b>Mark</b>	<b>Registration Date/Number</b>	<b>Class Description</b>
CAPTAIN MORGAN	November 13, 1973 972985	33 – Rum
CAPTAIN MORGAN	July 15, 2008 3466371	32 – Brewed malt-based alcoholic beverage in the nature of a beer
CAPTAIN MORGAN 1671	March 17, 2015 4705270	33 – Alcoholic beverages (except beers)
	October 17, 2006 3159948	33 – Alcoholic beverages, namely, distilled spirits

	April 10, 2012 4126073	33 – Alcoholic beverages (except beers)
CAPTAIN'S ORDERS!	January 29, 2013 4281706	33 – Alcoholic beverages (except beers)
CAPTAIN MORGAN TATTOO	May 27, 2008 3435812	33 – Distilled spirits
CAPTAIN MORGAN BLACK	February 12, 2013 4290286	33 – Alcoholic beverages (except beers)
	December 18, 2012 4260826	33 – Alcoholic beverages (except beers)
CAPTAIN MORGAN PARROT BAY	April 7, 2009 3603578	33 – Distilled spirits

Copies of the certificates and electronic status records for these registrations (“Opposer’s Registrations”) are attached as Exhibit A.

8. Applicant Destileria Coqui Inc. (“Applicant”) is a Puerto Rico corporation with an address of Parque Industrial Maria Luisa Arcelay, Mayagüez, Puerto Rico 00682.

9. By application Serial No. 86/366,388, Applicant seeks to register CAPTAIN MARY SPICED RUM for “rum” in International Class 33.

10. Applicant’s application was filed on an intent-to-use basis on August 14, 2014, long after Opposer commenced use of and registered Opposer’s Marks in the United States, and long after Opposer’s Marks became famous in the United States.

11. Applicant’s Mark is confusingly similar to Opposer’s Marks.

12. The goods for which Applicant seeks registration are closely related to and/or identical to, and likely to be perceived as closely related and/or identical to, those in connection with which Opposer uses and has used Opposer’s Marks in the United States.

13. The identifications of goods in Application Serial No. 86/366,388 and in Opposer’s Registrations are unrestricted as to classes of purchasers, channels of trade, and promotional media.

14. Opposer will be damaged by the registration sought by Applicant because that registration will support and assist Applicant in the confusing and misleading use of the mark sought to be registered, and will give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

15. Opposer also will be damaged by the registration sought by Applicant because that registration is likely to dilute the distinctiveness of Opposer's famous Marks.

16. Registration should be refused pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), on the ground that Applicant's Mark so closely resembles Opposer's Marks as to be likely, when used on or in connection with the goods identified in the Application, to cause confusion, or to cause mistake, or to deceive prospective consumers as to the origin, sponsorship or approval of Applicant's listed goods, with the consequent injury to Opposer and to the public.

17. Registration also should be refused pursuant to Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), on the ground that Applicant's Mark is likely to dilute the distinctiveness of Opposer's famous Marks.

18. Opposer therefore respectfully requests that the opposition be sustained by the Board and registration of Applicant's mark be denied pursuant to 15 U.S.C. §§ 1052(d), 1063 and 1125(c).

The required fee in the amount of \$300.00 accompanies this notice. The Commissioner is authorized to debit Kilpatrick Townsend & Stockton LLP's deposit account no. 20-1430 if there is a deficiency in the required fee.

Dated: June 17, 2015

Respectfully submitted,

/Brian P. O'Donnell/

Brian P. O'Donnell

Kilpatrick Townsend & Stockton LLP

1400 Wewatta Street, Suite 600

Denver, CO 80202

[bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com)

Theodore H. Davis, Jr.

Kilpatrick Townsend & Stockton LLP

1100 Peachtree Street NE, Suite 2800

Atlanta, GA 30309-4528

[tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

*Counsel for Opposer Diageo North America, Inc.*

67398791

**CERTIFICATE OF SERVICE**

I hereby certify that I have caused a true and correct copy of the foregoing NOTICE OF OPPOSITION to be served, via first class mail, postage prepaid, and electronic mail on this 17th day of June 2015, to Applicant as follows:

Destileria Coqui Inc.  
Attn: Hector A. Quinones Mercado  
Parque Industrial Maria Luisa Arcelay  
Módulo 2 Edificio 2  
Calle José A. Padilla  
Mayagüez, Puerto Rico 00682

Hector@prsugar.com

/Brian P. O'Donnell/  
Brian P. O'Donnell

**CERTIFICATE OF TRANSMITTAL**

I certify that a copy of the attached NOTICE OF OPPOSITION is being filed electronically with the TTAB via ESTTA on June 17, 2015.

/Brian P. O'Donnell/  
Brian P. O'Donnell

# **EXHIBIT A**

# United States Patent Office

972,985  
Registered Nov. 13, 1973

## PRINCIPAL REGISTER Trademark

Ser. No. 417,450, filed Mar. 6, 1972

### CAPTAIN MORGAN

The Huntington Creek Corporation, (Maryland corporation)  
375 Park Ave.  
New York, N.Y. 10022

For: RUM, in CLASS 49 (INT. CL. 33).  
First use Dec. 23, 1971; in commerce Dec. 23, 1971.

L. STRICKMAN, Examiner

**Generated on:** This page was generated by TSDR on 2015-06-15 15:12:27 EDT

**Mark:** CAPTAIN MORGAN

**US Serial Number:** 72417450  
**US Registration Number:** 972985  
**Register:** Principal  
**Mark Type:** Trademark  
**Status:** The registration has been renewed.  
**Status Date:** Jan. 08, 2013

**Application Filing Date:** Mar. 06, 1972  
**Registration Date:** Nov. 13, 1973

## Mark Information

**Mark Literal Elements:** CAPTAIN MORGAN  
**Standard Character Claim:** No  
**Mark Drawing Type:** 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** RUM  
**International Class(es):** 033  
**Class Status:** ACTIVE  
**Basis:** 1(a)  
**First Use:** Dec. 23, 1971

**U.S Class(es):** 049 - Primary Class  
**Use in Commerce:** Dec. 23, 1971

## Basis Information (Case Level)

<b>Filed Use:</b> Yes	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

**Owner Name:** DIAGEO NORTH AMERICA, INC.  
**Owner Address:** 801 Main Ave  
Norwalk, CONNECTICUT 06851  
UNITED STATES  
**Legal Entity Type:** CORPORATION  
**State or Country Where Organized:** CONNECTICUT

## Attorney/Correspondence Information

**Attorney of Record**

<b>Attorney Name:</b> Nicole D. D'Amato	<b>Docket Number:</b> 81052082
<b>Attorney Primary Email Address:</b> <a href="mailto:trademarks@diageo.com">trademarks@diageo.com</a>	<b>Attorney Email Authorized:</b> Yes

**Correspondent**

**Correspondent Name/Address:** Nicole D. D'Amato  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail** Yes  
**Authorized:**

**Domestic Representative - Not Found****Prosecution History**

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 08, 2013	NOTICE OF ACCEPTANCE OF SEC. 8 & 9 - E-MAILED	
Jan. 08, 2013	REGISTERED AND RENEWED (THIRD RENEWAL - 10 YRS)	67723
Jan. 08, 2013	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	67723
Dec. 31, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	67723
Dec. 07, 2012	TEAS SECTION 8 & 9 RECEIVED	
Aug. 29, 2008	CASE FILE IN TICRS	
Mar. 01, 2005	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Jan. 30, 2004	REGISTERED AND RENEWED (SECOND RENEWAL - 10 YRS)	
Jan. 30, 2004	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Nov. 02, 2003	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Nov. 12, 2003	TEAS SECTION 8 & 9 RECEIVED	
Aug. 05, 1993	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	
Jun. 02, 1993	REGISTERED - SEC. 9 FILED/CHECK RECORD FOR SEC. 8	
Apr. 02, 1979	REGISTERED - SEC. 8 (6-YR) ACCEPTED	

**Maintenance Filings or Post Registration Information**

**Affidavit of Continued Use:** Section 8 - Accepted

**Renewal Date:** Nov. 13, 2013

**TM Staff and Location Information**

**TM Staff Information - None**

**File Location**

**Current Location:** GENERIC WEB UPDATE

**Date in Location:** Jan. 08, 2013

**Assignment Abstract Of Title Information****Summary**

**Total Assignments:** 2

**Registrant:** HUNTINGTON CREEK CORPORATION, THE

**Assignment 1 of 2**

**Conveyance:** ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL

**Reel/Frame:** [0260/0098](#)

**Pages:** 2

**Date Recorded:** Nov. 04, 1974

**Supporting Documents:** No Supporting Documents Available

**Assignor**

**Name:** [HUNTINGTON CREEK CORPORATION, THE](#)

**Execution Date:** Sep. 30, 1974

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** MARYLAND

**Assignee**

**Name:** [JOSEPH E. SEAGRAM & SONS, INC.](#)

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** INDIANA

Address: 375 PARK AVENUE  
NEW YORK, NEW YORK 10022

#### Correspondent

Correspondent Name: JOSEPH E. SEAGRAM & SONS, INC.

Correspondent Address: 375 PARK AVENUE  
NEW YORK, NY 10022

#### Domestic Representative - Not Found

#### Assignment 2 of 2

Conveyance: MERGER

Reel/Frame: [2601/0770](#)

Pages: 13

Date Recorded: Jan. 22, 2003

Supporting Documents: [assignment-tm-2601-0770.pdf](#)

#### Assignor

Name: [JOSEPH E. SEAGRAM & SONS, INC.](#)

Execution Date: Dec. 11, 2002

Legal Entity Type: CORPORATION

State or Country Where  
Organized: INDIANA

#### Assignee

Name: [DIAGEO NORTH AMERICA, INC.](#)

Legal Entity Type: CORPORATION

State or Country Where  
Organized: CONNECTICUT

Address: SIX LANDMARK SQUARE  
STAMFORD, CONNECTICUT 06901

#### Correspondent

Correspondent Name: MORGAN, LEWIS & BOCKIUS LLP

Correspondent Address: CAROLE R. KLEIN  
1111 PENNSYLVANIA AVENUE, NW  
WASHINGTON, D.C. 20004

#### Domestic Representative - Not Found

## Proceedings

#### Summary

Number of Proceedings: 5

#### Type of Proceeding: Opposition

Proceeding Number: [91221751](#)

Filing Date: Apr 29, 2015

Status: Pending

Status Date: Apr 29, 2015

Interlocutory Attorney: YONG OH (RICHARD) KIM

#### Defendant

Name: Captain William G. MacDonald

Correspondent Address: JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

Correspondent e-mail: [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	

#### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

Correspondent e-mail: [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>

CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

#### Type of Proceeding: Cancellation

**Proceeding Number:** [92058590](#) **Filing Date:** Jan 30, 2014  
**Status:** Pending **Status Date:** Jan 30, 2014  
**Interlocutory Attorney:** MARY CATHERINE FAINT

#### Defendant

**Name:** Closed Joint Stock Company "United Wine & Spirits Distributors"  
**Correspondent Address:** ALEXANDER LAZOUSKI  
 LAZOUSKI IP LLC  
 14726 BOWFIN TER, SUITE 1  
 LAKEWOOD RANCH FL , 34202  
 UNITED STATES  
**Correspondent e-mail:** [info@lzlzlawoffice.com](mailto:info@lzlzlawoffice.com) , [al@lzlzlawoffice.com](mailto:al@lzlzlawoffice.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN'S CAT	Cancellation Pending	<a href="#">79113437</a>	<a href="#">4270399</a>

#### Plaintiff(s)

**Name:** Diageo North America, Inc.  
**Correspondent Address:** EVAN GOURVITZ  
 ROPES & GRAY LLP  
 1211 AVENUE OF THE AMERICAS  
 NEW YORK NY , 10036  
 UNITED STATES  
**Correspondent e-mail:** [trademarks@ropesgray.com](mailto:trademarks@ropesgray.com) , [evan.gourvitz@ropesgray.com](mailto:evan.gourvitz@ropesgray.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 30, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 30, 2014	Mar 11, 2014

3	PENDING, INSTITUTED	Jan 30, 2014
4	ANSWER	Mar 06, 2014
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Apr 10, 2014
6	SUSPENDED	May 07, 2014
7	D CHANGE OF CORRESP ADDRESS	Aug 06, 2014
8	P APPEARANCE / POWER OF ATTORNEY	Nov 06, 2014
9	STIP TO SUSP PEND SETTL NEGOTIATIONS	Nov 25, 2014
10	SUSPENDED	Nov 25, 2014
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jan 20, 2015
12	SUSPENDED	Jan 20, 2015
13	STIP TO SUSP PEND SETTL NEGOTIATIONS	Mar 19, 2015
14	SUSPENDED	Mar 19, 2015
15	STIP FOR EXT	Apr 30, 2015
16	EXTENSION OF TIME GRANTED	Apr 30, 2015

#### Type of Proceeding: Opposition

Proceeding Number: [91212689](#)

Filing Date: Sep 26, 2013

Status: Terminated

Status Date: Sep 19, 2014

Interlocutory Attorney: CHERYL S GOODMAN

#### Defendant

Name: Captain Fin Co., LLC

Correspondent Address: AMANDA J MOONEY  
GOODMAN MOONEY LLP  
8001 IRVINE CENTER DRIVE, SUITE 1170  
IRVINE CA , 92618  
UNITED STATES

Correspondent e-mail: [uspto@goodmanmooney.com](mailto:uspto@goodmanmooney.com) , [amanda@goodmanmooney.com](mailto:amanda@goodmanmooney.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Abandoned - After Inter-Partes Decision	<a href="#">85603265</a>	

#### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC  
801 MAIN AVENUE  
NORWALK CT , 06851  
UNITED STATES

Correspondent e-mail: [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jennifer.hamilton@diageo.com](mailto:jennifer.hamilton@diageo.com) , [trademarks@diageo.com](mailto:trademarks@diageo.com) , [mara.mccooley@diageo.com](mailto:mara.mccooley@diageo.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Partial Section 8 and 15 Accepted and Acknowledged	<a href="#">78978550</a>	<a href="#">3283932</a>
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

#### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 26, 2013	

2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 26, 2013	Nov 05, 2013
3	PENDING, INSTITUTED	Sep 26, 2013	
4	ANSWER	Nov 05, 2013	
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jan 03, 2014	
6	EXTENSION OF TIME GRANTED	Jan 24, 2014	
7	P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jun 18, 2014	
8	SUSPENDED	Jun 18, 2014	
9	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jul 30, 2014	
10	SUSPENDED	Jul 30, 2014	
11	W/DRAW OF APPLICATION W/O CONSENT	Sep 09, 2014	
12	BD DECISION: SUSTAINED	Sep 19, 2014	
13	TERMINATED	Sep 19, 2014	

#### Type of Proceeding: Opposition

**Proceeding Number:** [91204953](#)

**Filing Date:** Apr 30, 2012

**Status:** Terminated

**Status Date:** Jul 17, 2012

**Interlocutory Attorney:** GEORGE POLOGEORGIS

#### Defendant

**Name:** Coppenrath Verlag GMBH Co. KG

**Correspondent Address:** KARL F MILDE JR  
ECKERT SEAMANS CHERIN MELLOTT LLC  
US STEEL TOWER, 600 GRANT STREET 44 FLOOR  
PITTSBURGH PA , 15219 2713  
UNITED STATES

**Correspondent e-mail:** [IPmail@eckertseamans.com](mailto:IPmail@eckertseamans.com) , [kmilde@eckertseamans.com](mailto:kmilde@eckertseamans.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPT'N SHARKY	Registered	<a href="#">85095807</a>	<a href="#">4485472</a>

#### Plaintiff(s)

**Name:** Diageo North America, Inc.

**Correspondent Address:** EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC  
801 MAIN AVENUE  
NORFOLK CT , 06851  
UNITED STATES

**Correspondent e-mail:** [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.vendittelli@diageo.com](mailto:gina.vendittelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CM	Renewed	<a href="#">78410433</a>	<a href="#">3086378</a>

#### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 30, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 30, 2012	Jun 09, 2012
3	PENDING, INSTITUTED	Apr 30, 2012	
4	AMENDMENT	Jun 05, 2012	
5	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 21, 2012	Jul 21, 2012

6	P'S CONSENT TO AMENDMENT	Jun 26, 2012
7	RESPONSE DUE 30 DAYS (DUE DATE)	Jul 02, 2012 Aug 01, 2012
8	WITHDRAWAL OF OPPOSITION	Jul 17, 2012
9	BOARD'S DECISION: DISMISSED	Jul 17, 2012
10	TERMINATED	Jul 17, 2012

#### Type of Proceeding: Opposition

Proceeding Number: [91203745](#)

Filing Date: Feb 08, 2012

Status: Terminated

Status Date: Aug 27, 2013

Interlocutory Attorney: YONG OH (RICHARD) KIM

#### Defendant

Name: Captain Russell Corp.

Correspondent Address: MICHAEL DYAKIV  
CAPTAIN RUSSELL CORP  
20 SMITH ST , 2ND FLOOR  
RIVERSIDE RI , 02915  
UNITED STATES

Correspondent e-mail: [mdyakiv@gmail.com](mailto:mdyakiv@gmail.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN RUSSELL CUBA LIBRE	Abandoned - After Inter-Partes Decision	<a href="#">85372597</a>	

#### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: J KEVIN FEE  
MORGAN LEWIS BOCKIUS LLP  
1111 PENNSYLVANIA AVE NW  
WASHINGTON DC , 20004  
UNITED STATES

Correspondent e-mail: [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.vendittelli@diageo.com](mailto:gina.vendittelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jrubel@morganlewis.com](mailto:jrubel@morganlewis.com) , [jkfee@morganlewis.com](mailto:jkfee@morganlewis.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>

#### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 08, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 08, 2012	Mar 19, 2012
3	PENDING, INSTITUTED	Feb 08, 2012	
4	ANSWER	Mar 08, 2012	
5	CHANGE OF CORRESPONDENCE ADDRESS	Sep 12, 2012	
6	P'S MOTION FOR SUMMARY JUDGMENT	Dec 13, 2012	
7	DUPLICATE OF #6	Dec 13, 2012	
8	DECLARATION OF TOM HERBST EXHIBIT 3	Dec 13, 2012	
9	DECLARATION OF TOM HERBST EXHIBIT 4	Dec 13, 2012	
10	DECLARATION OF TOM HERBST EXHIBIT 4 PART B	Dec 13, 2012	
11	DECLARATION OF TOM HERBST EXHIBIT 4 PART C	Dec 13, 2012	
12	P EXH 2 - 11; DYAKIV DEPO., AMENDED NOTICE OF OPP	Dec 13, 2012	
13	D'S OPPOSITION/RESPONSE TO MOTION	Jan 12, 2013	

14	P'S REPLY IN SUPPORT OF MOTION	Jan 28, 2013
15	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 19, 2013
16	BD DECISION: SUSTAINED	Jun 12, 2013
17	TERMINATED	Aug 27, 2013

**Int. Cl.: 32**

**Prior U.S. Cls.: 45, 46 and 48**

**United States Patent and Trademark Office**

**Reg. No. 3,466,371**

**Registered July 15, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**

**CAPTAIN MORGAN**

DIAGEO NORTH AMERICA, INC. (CONNECTI-  
CUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

OWNER OF U.S. REG. NOS. 972,985, 3,159,948 AND  
OTHERS.

FOR: BREWED MALT-BASED ALCOHOLIC BEV-  
ERAGE IN THE NATURE OF A BEER, IN CLASS 32  
(U.S. CLS. 45, 46 AND 48).

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-  
TURE(S) SHOWN IN THE MARK DOES NOT IDEN-  
TIFY A PARTICULAR LIVING INDIVIDUAL.

FIRST USE 4-1-2006; IN COMMERCE 4-1-2006.

SER. NO. 77-303,060, FILED 10-12-2007.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

RON FAIRBANKS, EXAMINING ATTORNEY

**Generated on:** This page was generated by TSDR on 2015-06-15 15:13:38 EDT

**Mark:** CAPTAIN MORGAN

CAPTAIN MORGAN

<b>US Serial Number:</b> 77303060	<b>Application Filing Date:</b> Oct. 12, 2007
<b>US Registration Number:</b> 3466371	<b>Registration Date:</b> Jul. 15, 2008
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> A Sections 8 and 15 combined declaration has been accepted and acknowledged.	
<b>Status Date:</b> Jan. 24, 2015	
<b>Publication Date:</b> Apr. 29, 2008	

## Mark Information

**Mark Literal Elements:** CAPTAIN MORGAN

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

**Name Portrait Consent:** The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

## Related Properties Information

**Claimed Ownership of US Registrations:** 0972985, 1285506, 3159948 and others

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Brewed malt-based alcoholic beverage in the nature of a beer

<b>International Class(es):</b> 032 - Primary Class	<b>U.S Class(es):</b> 045, 046, 048
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> Apr. 01, 2006	<b>Use in Commerce:</b> Apr. 01, 2006

## Basis Information (Case Level)

<b>Filed Use:</b> Yes	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

<b>Owner Name:</b> Diageo North America, Inc.	
<b>Owner Address:</b> 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
<b>Legal Entity Type:</b> CORPORATION	<b>State or Country Where Organized:</b> CONNECTICUT

## Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer Hamilton

Attorney Primary Email [trademarks@Diageo.com](mailto:trademarks@Diageo.com)  
Address:

Attorney Email Yes  
Authorized:

#### Correspondent

**Correspondent Name/Address:** Jennifer Hamilton  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail** Yes  
**Authorized:**

#### Domestic Representative - Not Found

### Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 25, 2015	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Jan. 24, 2015	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	70131
Jan. 24, 2015	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	70131
Jan. 12, 2015	TEAS SECTION 8 & 15 RECEIVED	
Jul. 15, 2008	REGISTERED-PRINCIPAL REGISTER	
Apr. 29, 2008	PUBLISHED FOR OPPOSITION	
Apr. 09, 2008	NOTICE OF PUBLICATION	
Mar. 24, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Mar. 24, 2008	ASSIGNED TO LIE	77312
Mar. 07, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 04, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 04, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 04, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 30, 2007	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 30, 2007	NON-FINAL ACTION E-MAILED	6325
Dec. 30, 2007	NON-FINAL ACTION WRITTEN	76463
Dec. 22, 2007	ASSIGNED TO EXAMINER	76463
Oct. 17, 2007	NEW APPLICATION ENTERED IN TRAM	

### Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

### TM Staff and Location Information

#### TM Staff Information - None

##### File Location

**Current Location:** TMO LAW OFFICE 117

**Date in Location:** Jan. 24, 2015

### Proceedings

#### Summary

**Number of Proceedings:** 5

#### Type of Proceeding: Opposition

**Proceeding Number:** [91221751](#)

**Filing Date:** Apr 29, 2015

**Status:** Pending

**Status Date:** Apr 29, 2015

**Interlocutory Attorney:** YONG OH (RICHARD) KIM

Defendant			
<b>Name:</b> Captain William G. MacDonald			
<b>Correspondent Address:</b> JOHN S. EGBERT Egbert Law Offices PLLc 1314 Texas St Fl 21 Houston TX , 77002-6577			
<b>Correspondent e-mail:</b> <a href="mailto:mail@egbertlawoffices.com">mail@egbertlawoffices.com</a>			
Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	
Plaintiff(s)			
<b>Name:</b> Diageo North America, Inc.			
<b>Correspondent Address:</b> Brian P. O'Donnell Kilpatrick Townsend & Stockton LLP 1400 Wewatta Street, Suite 600 Denver CO , 80202 UNITED STATES			
<b>Correspondent e-mail:</b> <a href="mailto:denverteas@kilpatricktownsend.com">denverteas@kilpatricktownsend.com</a> , <a href="mailto:bodonnell@kilpatricktownsend.com">bodonnell@kilpatricktownsend.com</a> , <a href="mailto:tdavis@kilpatricktownsend.com">tdavis@kilpatricktownsend.com</a>			
Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>
Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	
Type of Proceeding: Cancellation			
<b>Proceeding Number:</b> <a href="#">92058590</a>		<b>Filing Date:</b> Jan 30, 2014	
<b>Status:</b> Pending		<b>Status Date:</b> Jan 30, 2014	
<b>Interlocutory Attorney:</b> MARY CATHERINE FAINT			
Defendant			
<b>Name:</b> Closed Joint Stock Company "United Wine & Spirits Distributors"			
<b>Correspondent Address:</b> ALEXANDER LAZOUSKI LAZOUSKI IP LLC 14726 BOWFIN TER, SUITE 1 LAKEWOOD RANCH FL , 34202 UNITED STATES			
<b>Correspondent e-mail:</b> <a href="mailto:info@lzlzlawoffice.com">info@lzlzlawoffice.com</a> , <a href="mailto:al@lzlzlawoffice.com">al@lzlzlawoffice.com</a>			
Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN'S CAT	Cancellation Pending	<a href="#">79113437</a>	<a href="#">4270399</a>
Plaintiff(s)			
<b>Name:</b> Diageo North America, Inc.			

**Correspondent Address:** EVAN GOURVITZ  
ROPES & GRAY LLP  
1211 AVENUE OF THE AMERICAS  
NEW YORK NY , 10036  
UNITED STATES

**Correspondent e-mail:** [trademarks@ropesgray.com](mailto:trademarks@ropesgray.com) , [evan.gourvitz@ropesgray.com](mailto:evan.gourvitz@ropesgray.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 30, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 30, 2014	Mar 11, 2014
3	PENDING, INSTITUTED	Jan 30, 2014	
4	ANSWER	Mar 06, 2014	
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Apr 10, 2014	
6	SUSPENDED	May 07, 2014	
7	D CHANGE OF CORRESP ADDRESS	Aug 06, 2014	
8	P APPEARANCE / POWER OF ATTORNEY	Nov 06, 2014	
9	STIP TO SUSP PEND SETTL NEGOTIATIONS	Nov 25, 2014	
10	SUSPENDED	Nov 25, 2014	
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jan 20, 2015	
12	SUSPENDED	Jan 20, 2015	
13	STIP TO SUSP PEND SETTL NEGOTIATIONS	Mar 19, 2015	
14	SUSPENDED	Mar 19, 2015	
15	STIP FOR EXT	Apr 30, 2015	
16	EXTENSION OF TIME GRANTED	Apr 30, 2015	

**Type of Proceeding: Opposition**

**Proceeding Number:** [91212689](#)

**Filing Date:** Sep 26, 2013

**Status:** Terminated

**Status Date:** Sep 19, 2014

**Interlocutory Attorney:** CHERYL S GOODMAN

**Defendant**

**Name:** Captain Fin Co., LLC

**Correspondent Address:** AMANDA J MOONEY  
GOODMAN MOONEY LLP  
8001 IRVINE CENTER DRIVE, SUITE 1170  
IRVINE CA , 92618  
UNITED STATES

**Correspondent e-mail:** [uspto@goodmanmooney.com](mailto:uspto@goodmanmooney.com) , [amanda@goodmanmooney.com](mailto:amanda@goodmanmooney.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Abandoned - After Inter-Partes Decision	<a href="#">85603265</a>	

**Plaintiff(s)**

**Name:** Diageo North America, Inc.

**Correspondent Address:** EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC

801 MAIN AVENUE  
NORWALK CT , 06851  
UNITED STATES

Correspondent e-mail: [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jennifer.hamilton@diageo.com](mailto:jennifer.hamilton@diageo.com) , [trademarks@diageo.com](mailto:trademarks@diageo.com) , [mara.mccooley@diageo.com](mailto:mara.mccooley@diageo.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Partial Section 8 and 15 Accepted and Acknowledged	<a href="#">78978550</a>	<a href="#">3283932</a>
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 26, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 26, 2013	Nov 05, 2013
3	PENDING, INSTITUTED	Sep 26, 2013	
4	ANSWER	Nov 05, 2013	
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jan 03, 2014	
6	EXTENSION OF TIME GRANTED	Jan 24, 2014	
7	P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jun 18, 2014	
8	SUSPENDED	Jun 18, 2014	
9	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jul 30, 2014	
10	SUSPENDED	Jul 30, 2014	
11	W/DRAW OF APPLICATION W/O CONSENT	Sep 09, 2014	
12	BD DECISION: SUSTAINED	Sep 19, 2014	
13	TERMINATED	Sep 19, 2014	

**Type of Proceeding: Opposition**

Proceeding Number: [91204953](#)

Filing Date: Apr 30, 2012

Status: Terminated

Status Date: Jul 17, 2012

Interlocutory Attorney: GEORGE POLOGEORGIS

**Defendant**

Name: Coppenrath Verlag GMBH Co. KG

Correspondent Address: KARL F MILDE JR  
ECKERT SEAMANS CHERIN MELLOTT LLC  
US STEEL TOWER, 600 GRANT STREET 44 FLOOR  
PITTSBURGH PA , 15219 2713  
UNITED STATES

Correspondent e-mail: [IPmail@eckertseamans.com](mailto:IPmail@eckertseamans.com) , [kmilde@eckertseamans.com](mailto:kmilde@eckertseamans.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPT'N SHARKY	Registered	<a href="#">85095807</a>	<a href="#">4485472</a>

**Plaintiff(s)**

Name: Diageo North America, Inc.

Correspondent Address: EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC  
801 MAIN AVENUE  
NORFOLK CT , 06851  
UNITED STATES

Correspondent e-mail: [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.venditelli@diageo.com](mailto:gina.venditelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CM	Renewed	<a href="#">78410433</a>	<a href="#">3086378</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 30, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 30, 2012	Jun 09, 2012
3	PENDING, INSTITUTED	Apr 30, 2012	
4	AMENDMENT	Jun 05, 2012	
5	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 21, 2012	Jul 21, 2012
6	P'S CONSENT TO AMENDMENT	Jun 26, 2012	
7	RESPONSE DUE 30 DAYS (DUE DATE)	Jul 02, 2012	Aug 01, 2012
8	WITHDRAWAL OF OPPOSITION	Jul 17, 2012	
9	BOARD'S DECISION: DISMISSED	Jul 17, 2012	
10	TERMINATED	Jul 17, 2012	

#### Type of Proceeding: Opposition

Proceeding Number: [91203745](#)

Filing Date: Feb 08, 2012

Status: Terminated

Status Date: Aug 27, 2013

Interlocutory Attorney: YONG OH (RICHARD) KIM

#### Defendant

Name: Captain Russell Corp.

Correspondent Address: MICHAEL DYAKIV  
CAPTAIN RUSSELL CORP  
20 SMITH ST , 2ND FLOOR  
RIVERSIDE RI , 02915  
UNITED STATES

Correspondent e-mail: [mdyakiv@gmail.com](mailto:mdyakiv@gmail.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN RUSSELL CUBA LIBRE	Abandoned - After Inter-Partes Decision	<a href="#">85372597</a>	

#### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: J KEVIN FEE  
MORGAN LEWIS BOCKIUS LLP  
1111 PENNSYLVANIA AVE NW  
WASHINGTON DC , 20004  
UNITED STATES

Correspondent e-mail: [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.vendittelli@diageo.com](mailto:gina.vendittelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jrubel@morganlewis.com](mailto:jrubel@morganlewis.com) , [jfee@morganlewis.com](mailto:jfee@morganlewis.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>

CAPTAIN MORGAN

Section 8 and 15 - Accepted and  
Acknowledged

[78410544](#) [3159948](#)

CAPTAIN

Registered

[77283163](#) [3805205](#)

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 08, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 08, 2012	Mar 19, 2012
3	PENDING, INSTITUTED	Feb 08, 2012	
4	ANSWER	Mar 08, 2012	
5	CHANGE OF CORRESPONDENCE ADDRESS	Sep 12, 2012	
6	P'S MOTION FOR SUMMARY JUDGMENT	Dec 13, 2012	
7	DUPLICATE OF #6	Dec 13, 2012	
8	DECLARATION OF TOM HERBST EXHIBIT 3	Dec 13, 2012	
9	DECLARATION OF TOM HERBST EXHIBIT 4	Dec 13, 2012	
10	DECLARATION OF TOM HERBST EXHIBIT 4 PART B	Dec 13, 2012	
11	DECLARATION OF TOM HERBST EXHIBIT 4 PART C	Dec 13, 2012	
12	P EXH 2 - 11; DYAKIV DEPO., AMENDED NOTICE OF OPP	Dec 13, 2012	
13	D'S OPPOSITION/RESPONSE TO MOTION	Jan 12, 2013	
14	P'S REPLY IN SUPPORT OF MOTION	Jan 28, 2013	
15	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 19, 2013	
16	BD DECISION: SUSTAINED	Jun 12, 2013	
17	TERMINATED	Aug 27, 2013	

# United States of America

United States Patent and Trademark Office

## CAPTAIN MORGAN 1671

**Reg. No. 4,705,270**

**Registered Mar. 17, 2015**

**Int. Cl.: 33**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 5-31-2014; IN COMMERCE 5-31-2014.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 972,985, 3,509,465, AND OTHERS.

SN 86-249,606, FILED 4-11-2014.

KARANENDRA S. CHHINA, EXAMINING ATTORNEY



*Michelle K. Lee*

Director of the United States  
Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the United States Patent and Trademark Office (USPTO). The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**NOTE: A courtesy e-mail reminder of USPTO maintenance filing deadlines will be sent to trademark owners/holders who authorize e-mail communication and maintain a current e-mail address with the USPTO. To ensure that e-mail is authorized and your address is current, please use the Trademark Electronic Application System (TEAS) Correspondence Address and Change of Owner Address Forms available at <http://www.uspto.gov>.**

**Generated on:** This page was generated by TSDR on 2015-06-15 15:25:41 EDT

**Mark:** CAPTAIN MORGAN 1671

CAPTAIN MORGAN 1671

<b>US Serial Number:</b> 86249606	<b>Application Filing Date:</b> Apr. 11, 2014
<b>US Registration Number:</b> 4705270	<b>Registration Date:</b> Mar. 17, 2015
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> Registered. The registration date is used to determine when post-registration maintenance documents are due.	
<b>Status Date:</b> Mar. 17, 2015	
<b>Publication Date:</b> Aug. 19, 2014	<b>Notice of Allowance Date:</b> Oct. 14, 2014

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## Mark Information

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**Mark Literal Elements:** CAPTAIN MORGAN 1671

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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## Related Properties Information

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**Claimed Ownership of US Registrations:** 0972985, 1285506, 3509465 and others

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

<b>For:</b> Alcoholic beverages except beers	
<b>International Class(es):</b> 033 - Primary Class	<b>U.S Class(es):</b> 047, 049
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> May 31, 2014	<b>Use in Commerce:</b> May 31, 2014

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## Basis Information (Case Level)

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<b>Filed Use:</b> No	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> Yes	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

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## Current Owner(s) Information

---

<b>Owner Name:</b> Diageo North America, Inc.	
<b>Owner Address:</b> 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
<b>Legal Entity Type:</b> CORPORATION	<b>State or Country Where Organized:</b> CONNECTICUT

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## Attorney/Correspondence Information

---

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### Attorney of Record

**Attorney Name:** Jennifer Hamilton

Attorney Primary Email [trademarks@diageo.com](mailto:trademarks@diageo.com)  
Address:

Attorney Email Yes  
Authorized:

#### Correspondent

**Correspondent Name/Address:** JENNIFER HAMILTON  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail** Yes  
**Authorized:**

#### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 17, 2015	REGISTERED-PRINCIPAL REGISTER	
Feb. 12, 2015	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Feb. 11, 2015	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 22, 2015	STATEMENT OF USE PROCESSING COMPLETE	71034
Dec. 09, 2014	USE AMENDMENT FILED	71034
Jan. 22, 2015	CASE ASSIGNED TO INTENT TO USE PARALEGAL	71034
Dec. 09, 2014	TEAS STATEMENT OF USE RECEIVED	
Nov. 21, 2014	TEAS STATEMENT OF USE RECEIVED	
Oct. 14, 2014	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Aug. 19, 2014	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 19, 2014	PUBLISHED FOR OPPOSITION	
Jul. 30, 2014	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 14, 2014	LAW OFFICE PUBLICATION REVIEW COMPLETED	70884
Jul. 14, 2014	ASSIGNED TO LIE	70884
Jun. 26, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 12, 2014	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
May 31, 2014	WITHDRAWN FROM PUB - OG REVIEW QUERY	76621
May 14, 2014	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 30, 2014	ASSIGNED TO EXAMINER	76741
Apr. 25, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 15, 2014	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

#### TM Staff Information - None

#### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Feb. 11, 2015

## Proceedings

#### Summary

**Number of Proceedings:** 1

#### Type of Proceeding: Opposition

**Proceeding Number:** [91221751](#)

**Filing Date:** Apr 29, 2015

**Status:** Pending

**Status Date:** Apr 29, 2015

**Interlocutory Attorney:** YONG OH (RICHARD) KIM

#### Defendant

**Name:** Captain William G. MacDonald

**Correspondent Address:** JOHN S. EGBERT  
Egbert Law Offices PLLC

1314 Texas St Fl 21  
Houston TX , 77002-6577

Correspondent e-mail: [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	
Plaintiff(s)			

Name: Diageo North America, Inc.

Correspondent Address: Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

Correspondent e-mail: [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

**Int. Cl.: 33**

**Prior U.S. Cls.: 47 and 49**

**United States Patent and Trademark Office**

**Reg. No. 3,159,948**

**Registered Oct. 17, 2006**

**TRADEMARK  
PRINCIPAL REGISTER**

The logo for Captain Morgan, featuring the brand name in a stylized, gothic-style font. The letters are black with a white outline, and the text is set against a background of small, light gray dots.

DIAGEO NORTH AMERICA, INC. (CONNECTI-  
CUT CORPORATION)  
801 MAIN AVE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGE, NAMELY, DIS-  
TILLED SPIRITS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 4-15-1982; IN COMMERCE 4-15-1982.

THE NAME IN THE MARK DOES NOT IDENTI-  
FY A LIVING INDIVIDUAL.

SN 78-410,544, FILED 4-29-2004.

CHERYL CLAYTON, EXAMINING ATTORNEY

**Generated on:** This page was generated by TSDR on 2015-06-15 15:26:32 EDT

**Mark:** CAPTAIN MORGAN



**US Serial Number:** 78410544

**Application Filing Date:** Apr. 29, 2004

**US Registration Number:** 3159948

**Registration Date:** Oct. 17, 2006

**Register:** Principal

**Mark Type:** Trademark

**Status:** A Sections 8 and 15 combined declaration has been accepted and acknowledged.

**Status Date:** Mar. 21, 2012

**Publication Date:** Nov. 09, 2004

**Notice of Allowance Date:** Feb. 01, 2005

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## Mark Information

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**Mark Literal Elements:** CAPTAIN MORGAN

**Standard Character Claim:** No

**Mark Drawing Type:** 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

**Color(s) Claimed:** Color is not claimed as a feature of the mark.

**Name Portrait Consent:** The name in the mark does not identify a living individual.

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Alcoholic Beverage, namely, distilled spirits

**International Class(es):** 033 - Primary Class

**U.S Class(es):** 047, 049

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Apr. 15, 1982

**Use in Commerce:** Apr. 15, 1982

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## Basis Information (Case Level)

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**Filed Use:** No

**Currently Use:** Yes

**Amended Use:** No

**Filed ITU:** Yes

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

---

## Current Owner(s) Information

---

**Owner Name:** Diageo North America, Inc.

**Owner Address:** 801 Main Ave  
Norwalk, CONNECTICUT 06851  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where  
Organized:** CONNECTICUT

---

## Attorney/Correspondence Information

---

**Attorney of Record**

**Attorney Name:** Nicole D'Amato

**Attorney Primary Email Address:** [trademarks@diageo.com](mailto:trademarks@diageo.com)

**Attorney Email Authorized:** Yes

**Correspondent**

**Correspondent Name/Address:** Nicole D'Amato  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail Authorized:** Yes

**Domestic Representative - Not Found**

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Mar. 21, 2012	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Mar. 21, 2012	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	68335
Mar. 21, 2012	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	68335
Feb. 13, 2012	TEAS SECTION 8 & 15 RECEIVED	
Oct. 08, 2008	NOTICE OF SUIT	
Oct. 17, 2006	REGISTERED-PRINCIPAL REGISTER	
Aug. 31, 2006	LAW OFFICE REGISTRATION REVIEW COMPLETED	70138
Aug. 25, 2006	ASSIGNED TO LIE	70138
Aug. 22, 2006	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jul. 13, 2006	STATEMENT OF USE PROCESSING COMPLETE	71280
Jul. 13, 2006	EXTENSION 3 GRANTED	71280
Jun. 21, 2006	USE AMENDMENT FILED	71280
Jun. 21, 2006	EXTENSION 3 FILED	71280
Jun. 21, 2006	TEAS EXTENSION RECEIVED	
Jun. 21, 2006	TEAS STATEMENT OF USE RECEIVED	
Feb. 24, 2006	EXTENSION 2 GRANTED	64657
Feb. 01, 2006	EXTENSION 2 FILED	64657
Feb. 01, 2006	PAPER RECEIVED	
Jan. 31, 2006	EXTENSION 1 GRANTED	70565
Aug. 01, 2005	EXTENSION 1 FILED	70565
Jan. 03, 2006	EXTENSION RECEIVED WITH TEAS PETITION	
Jan. 03, 2006	PETITION TO REVIVE-GRANTED	88889
Jan. 03, 2006	TEAS PETITION TO REVIVE RECEIVED	
Jan. 03, 2006	ATTORNEY REVOKED AND/OR APPOINTED	
Jan. 03, 2006	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Mar. 01, 2005	TEAS CHANGE OF OWNER ADDRESS RECEIVED	
Feb. 01, 2005	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Nov. 09, 2004	PUBLISHED FOR OPPOSITION	
Oct. 20, 2004	NOTICE OF PUBLICATION	
Aug. 21, 2004	LAW OFFICE PUBLICATION REVIEW COMPLETED	74221
Aug. 18, 2004	ASSIGNED TO LIE	74221
Aug. 09, 2004	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 09, 2004	EXAMINERS AMENDMENT E-MAILED	6328
Aug. 06, 2004	ASSIGNED TO EXAMINER	77300
May 06, 2004	NEW APPLICATION ENTERED IN TRAM	

## Maintenance Filings or Post Registration Information

Affidavit of Continued Use: Section 8 - Accepted

Affidavit of Incontestability: Section 15 - Accepted

### TM Staff and Location Information

#### TM Staff Information - None

##### File Location

Current Location: TMEG LAW OFFICE 102

Date in Location: Mar. 21, 2012

### Proceedings

#### Summary

Number of Proceedings: 5

#### Type of Proceeding: Opposition

Proceeding Number: [91221751](#)

Filing Date: Apr 29, 2015

Status: Pending

Status Date: Apr 29, 2015

Interlocutory Attorney: YONG OH (RICHARD) KIM

#### Defendant

Name: Captain William G. MacDonald

Correspondent Address: JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

Correspondent e-mail: [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	

#### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

Correspondent e-mail: [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

#### Prosecution History

Entry Number	History Text	Date	Due Date
	FILED AND FEE		

1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

**Type of Proceeding: Cancellation**

**Proceeding Number:** [92058590](#)

**Filing Date:** Jan 30, 2014

**Status:** Pending

**Status Date:** Jan 30, 2014

**Interlocutory Attorney:** MARY CATHERINE FAINT

**Defendant**

**Name:** Closed Joint Stock Company "United Wine & Spirits Distributors"

**Correspondent Address:** ALEXANDER LAZOUSKI  
LAZOUSKI IP LLC  
14726 BOWFIN TER, SUITE 1  
LAKEWOOD RANCH FL , 34202  
UNITED STATES

**Correspondent e-mail:** [info@lzlawoffice.com](mailto:info@lzlawoffice.com) , [al@lzlawoffice.com](mailto:al@lzlawoffice.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN'S CAT	Cancellation Pending	<a href="#">79113437</a>	<a href="#">4270399</a>

**Plaintiff(s)**

**Name:** Diageo North America, Inc.

**Correspondent Address:** EVAN GOURVITZ  
ROPES & GRAY LLP  
1211 AVENUE OF THE AMERICAS  
NEW YORK NY , 10036  
UNITED STATES

**Correspondent e-mail:** [trademarks@ropesgray.com](mailto:trademarks@ropesgray.com) , [evan.gourvitz@ropesgray.com](mailto:evan.gourvitz@ropesgray.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Jan 30, 2014	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Jan 30, 2014	Mar 11, 2014
3	PENDING, INSTITUTED	Jan 30, 2014	
4	ANSWER	Mar 06, 2014	
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Apr 10, 2014	
6	SUSPENDED	May 07, 2014	
7	D CHANGE OF CORRESP ADDRESS	Aug 06, 2014	
8	P APPEARANCE / POWER OF ATTORNEY	Nov 06, 2014	
9	STIP TO SUSP PEND SETTL NEGOTIATIONS	Nov 25, 2014	
10	SUSPENDED	Nov 25, 2014	
11	STIP TO SUSP PEND SETTL NEGOTIATIONS	Jan 20, 2015	
12	SUSPENDED	Jan 20, 2015	
13	STIP TO SUSP PEND SETTL NEGOTIATIONS	Mar 19, 2015	
14	SUSPENDED	Mar 19, 2015	

15	STIP FOR EXT	Apr 30, 2015
16	EXTENSION OF TIME GRANTED	Apr 30, 2015

**Type of Proceeding: Opposition**

**Proceeding Number:** [91212689](#)

**Filing Date:** Sep 26, 2013

**Status:** Terminated

**Status Date:** Sep 19, 2014

**Interlocutory Attorney:** CHERYL S GOODMAN

**Defendant**

**Name:** Captain Fin Co., LLC

**Correspondent Address:** AMANDA J MOONEY  
GOODMAN MOONEY LLP  
8001 IRVINE CENTER DRIVE, SUITE 1170  
IRVINE CA , 92618  
UNITED STATES

**Correspondent e-mail:** [uspto@goodmanmooney.com](mailto:uspto@goodmanmooney.com) , [amanda@goodmanmooney.com](mailto:amanda@goodmanmooney.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Abandoned - After Inter-Partes Decision	<a href="#">85603265</a>	

**Plaintiff(s)**

**Name:** Diageo North America, Inc.

**Correspondent Address:** EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC  
801 MAIN AVENUE  
NORWALK CT , 06851  
UNITED STATES

**Correspondent e-mail:** [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jennifer.hamilton@diageo.com](mailto:jennifer.hamilton@diageo.com) , [trademarks@diageo.com](mailto:trademarks@diageo.com) , [maria.mccooey@diageo.com](mailto:maria.mccooey@diageo.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Partial Section 8 and 15 Accepted and Acknowledged	<a href="#">78978550</a>	<a href="#">3283932</a>
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN & COLA	Registered	<a href="#">77284602</a>	<a href="#">4006422</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Sep 26, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Sep 26, 2013	Nov 05, 2013
3	PENDING, INSTITUTED	Sep 26, 2013	
4	ANSWER	Nov 05, 2013	
5	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jan 03, 2014	
6	EXTENSION OF TIME GRANTED	Jan 24, 2014	
7	P MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jun 18, 2014	
8	SUSPENDED	Jun 18, 2014	
9	D MOT TO SUSP W/ CONSENT PEND SETTL NEGOTIATIONS	Jul 30, 2014	
10	SUSPENDED	Jul 30, 2014	
11	W/DRAW OF APPLICATION W/O CONSENT	Sep 09, 2014	
12	BD DECISION: SUSTAINED	Sep 19, 2014	
13	TERMINATED	Sep 19, 2014	

**Type of Proceeding: Opposition**

Proceeding Number: [91204953](#)

Filing Date: Apr 30, 2012

Status: Terminated

Status Date: Jul 17, 2012

Interlocutory Attorney: GEORGE POLOGEORGIS

**Defendant**

Name: Coppenrath Verlag GMBH Co. KG

Correspondent Address: KARL F MILDE JR  
ECKERT SEAMANS CHERIN MELLOTT LLC  
US STEEL TOWER, 600 GRANT STREET 44 FLOOR  
PITTSBURGH PA , 15219 2713  
UNITED STATES

Correspondent e-mail: [IPmail@eckertseamans.com](mailto:IPmail@eckertseamans.com) , [kmilde@eckertseamans.com](mailto:kmilde@eckertseamans.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPT'N SHARKY	Registered	<a href="#">85095807</a>	<a href="#">4485472</a>

**Plaintiff(s)**

Name: Diageo North America, Inc.

Correspondent Address: EVAN GOURVITZ  
DIAGEO NORTH AMERICA INC  
801 MAIN AVENUE  
NORFOLK CT , 06851  
UNITED STATES

Correspondent e-mail: [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.vendittelli@diageo.com](mailto:gina.vendittelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CM	Renewed	<a href="#">78410433</a>	<a href="#">3086378</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 30, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 30, 2012	Jun 09, 2012
3	PENDING, INSTITUTED	Apr 30, 2012	
4	AMENDMENT	Jun 05, 2012	
5	RESPONSE DUE 30 DAYS (DUE DATE)	Jun 21, 2012	Jul 21, 2012
6	P'S CONSENT TO AMENDMENT	Jun 26, 2012	
7	RESPONSE DUE 30 DAYS (DUE DATE)	Jul 02, 2012	Aug 01, 2012
8	WITHDRAWAL OF OPPOSITION	Jul 17, 2012	
9	BOARD'S DECISION: DISMISSED	Jul 17, 2012	
10	TERMINATED	Jul 17, 2012	

**Type of Proceeding: Opposition**

Proceeding Number: [91203745](#)

Filing Date: Feb 08, 2012

Status: Terminated

Status Date: Aug 27, 2013

Interlocutory Attorney: YONG OH (RICHARD) KIM

**Defendant**

Name: Captain Russell Corp.

Correspondent Address: MICHAEL DYAKIV  
CAPTAIN RUSSELL CORP  
20 SMITH ST , 2ND FLOOR  
RIVERSIDE RI , 02915  
UNITED STATES

Correspondent e-mail: [mdyakiv@gmail.com](mailto:mdyakiv@gmail.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN RUSSELL CUBA LIBRE	Abandoned - After Inter-Partes Decision	<a href="#">85372597</a>	
Plaintiff(s)			

**Name:** Diageo North America, Inc.

**Correspondent Address:** J KEVIN FEE  
MORGAN LEWIS BOCKIUS LLP  
1111 PENNSYLVANIA AVE NW  
WASHINGTON DC , 20004  
UNITED STATES

**Correspondent e-mail:** [trademarks@diageo.com](mailto:trademarks@diageo.com) , [gina.vendittelli@diageo.com](mailto:gina.vendittelli@diageo.com) , [nicole.damato@diageo.com](mailto:nicole.damato@diageo.com) , [evan.gourvitz@diageo.com](mailto:evan.gourvitz@diageo.com) , [jrubel@morganlewis.com](mailto:jrubel@morganlewis.com) , [jkfee@morganlewis.com](mailto:jkfee@morganlewis.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77184278</a>	<a href="#">3509465</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN	Registered	<a href="#">77283163</a>	<a href="#">3805205</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Feb 08, 2012	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Feb 08, 2012	Mar 19, 2012
3	PENDING, INSTITUTED	Feb 08, 2012	
4	ANSWER	Mar 08, 2012	
5	CHANGE OF CORRESPONDENCE ADDRESS	Sep 12, 2012	
6	P'S MOTION FOR SUMMARY JUDGMENT	Dec 13, 2012	
7	DUPLICATE OF #6	Dec 13, 2012	
8	DECLARATION OF TOM HERBST EXHIBIT 3	Dec 13, 2012	
9	DECLARATION OF TOM HERBST EXHIBIT 4	Dec 13, 2012	
10	DECLARATION OF TOM HERBST EXHIBIT 4 PART B	Dec 13, 2012	
11	DECLARATION OF TOM HERBST EXHIBIT 4 PART C	Dec 13, 2012	
12	P EXH 2 - 11; DYAKIV DEPO., AMENDED NOTICE OF OPP	Dec 13, 2012	
13	D'S OPPOSITION/RESPONSE TO MOTION	Jan 12, 2013	
14	P'S REPLY IN SUPPORT OF MOTION	Jan 28, 2013	
15	SUSP PEND DISP OF OUTSTNDNG MOT	Mar 19, 2013	
16	BD DECISION: SUSTAINED	Jun 12, 2013	
17	TERMINATED	Aug 27, 2013	

# United States of America

United States Patent and Trademark Office

# Captain Morgan

**Reg. No. 4,126,073**

**Registered Apr. 10, 2012**

**Int. Cl.: 33**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 11-30-2011; IN COMMERCE 11-30-2011.

OWNER OF U.S. REG. NOS. 972,985, 3,509,465, AND OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNATURE(S) SHOWN IN THE MARK DOES NOT IDENTIFY A PARTICULAR LIVING INDIVIDUAL.

THE MARK CONSISTS OF THE WORDS "CAPTAIN" AND "MORGAN" IN A STYLIZED FONT.

SN 85-039,011, FILED 5-14-2010.

HEATHER THOMPSON, EXAMINING ATTORNEY



*David J. Kyjars*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

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Mark: CAPTAIN MORGAN



US Serial Number: 85039011	Application Filing Date: May 14, 2010
US Registration Number: 4126073	Registration Date: Apr. 10, 2012
Filed as TEAS Plus: Yes	Currently TEAS Plus: Yes
Register: Principal	
Mark Type: Trademark	
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.	
Status Date: Apr. 10, 2012	
Publication Date: Jul. 27, 2010	Notice of Allowance Date: Sep. 21, 2010

## Mark Information

Mark Literal Elements: CAPTAIN MORGAN

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Description of Mark: The mark consists of the words "CAPTAIN" and "MORGAN" in a stylized font.

Color(s) Claimed: Color is not claimed as a feature of the mark.

Name Portrait Consent: The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

## Related Properties Information

Claimed Ownership of US Registrations: 0972985, 2168573, 3509465 and others

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*...\* identify additional (new) wording in the goods/services.

For: Alcoholic beverages except beers	
International Class(es): 033 - Primary Class	U.S Class(es): 047, 049
Class Status: ACTIVE	
Basis: 1(a)	
First Use: Nov. 30, 2011	Use in Commerce: Nov. 30, 2011

## Basis Information (Case Level)

Filed Use: No	Currently Use: Yes	Amended Use: No
Filed ITU: Yes	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

## Current Owner(s) Information

Owner Name: Diageo North America, Inc.	
Owner Address: 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
Legal Entity Type: CORPORATION	State or Country Where Organized: CONNECTICUT

## Attorney/Correspondence Information

Attorney of Record	
<b>Attorney Name:</b> Lauren Mandell <b>Attorney Primary Email Address:</b> <a href="mailto:trademarks@diageo.com">trademarks@diageo.com</a>	<b>Attorney Email Authorized:</b> No
Correspondent	
<b>Correspondent Name/Address:</b> LAUREN MANDELL Diageo North America, Inc. 801 Main Avenue Norwalk, CONNECTICUT 06851-1127 UNITED STATES  <b>Phone:</b> (203) 229-2100	
<b>Correspondent e-mail:</b> <a href="mailto:diageodocketing@ashurst.com">diageodocketing@ashurst.com</a>	<b>Correspondent e-mail Authorized:</b> Yes
Domestic Representative - Not Found	

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 10, 2012	REGISTERED-PRINCIPAL REGISTER	
Mar. 07, 2012	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Mar. 06, 2012	LAW OFFICE REGISTRATION REVIEW COMPLETED	77312
Mar. 03, 2012	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Feb. 23, 2012	STATEMENT OF USE PROCESSING COMPLETE	66230
Feb. 15, 2012	USE AMENDMENT FILED	66230
Feb. 15, 2012	TEAS STATEMENT OF USE RECEIVED	
Jun. 22, 2011	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jun. 20, 2011	EXTENSION 2 GRANTED	98765
Jun. 20, 2011	EXTENSION 2 FILED	98765
Jun. 20, 2011	TEAS EXTENSION RECEIVED	
Jan. 13, 2011	NOTICE OF APPROVAL OF EXTENSION REQUEST E-MAILED	
Jan. 12, 2011	EXTENSION 1 GRANTED	66230
Dec. 13, 2010	EXTENSION 1 FILED	66230
Jan. 11, 2011	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Dec. 13, 2010	TEAS EXTENSION RECEIVED	
Sep. 21, 2010	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Jul. 27, 2010	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 27, 2010	PUBLISHED FOR OPPOSITION	
Jun. 22, 2010	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Jun. 22, 2010	ASSIGNED TO LIE	77312
Jun. 06, 2010	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 03, 2010	ASSIGNED TO EXAMINER	76076
May 19, 2010	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
May 18, 2010	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

TM Staff Information - None	
File Location	
<b>Current Location:</b> PUBLICATION AND ISSUE SECTION	<b>Date in Location:</b> Mar. 06, 2012

## Proceedings

Summary
<b>Number of Proceedings:</b> 1

**Type of Proceeding: Opposition****Proceeding Number:** [91221751](#)**Filing Date:** Apr 29, 2015**Status:** Pending**Status Date:** Apr 29, 2015**Interlocutory Attorney:** YONG OH (RICHARD) KIM**Defendant****Name:** Captain William G. MacDonald**Correspondent Address:** JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577**Correspondent e-mail:** [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	

**Plaintiff(s)****Name:** Diageo North America, Inc.**Correspondent Address:** Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES**Correspondent e-mail:** [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

# United States of America

United States Patent and Trademark Office

## CAPTAIN'S ORDERS!

**Reg. No. 4,281,706**

**Registered Jan. 29, 2013**

**Int. Cl.: 33**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 1-0-2004; IN COMMERCE 1-0-2004.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,050,890.

SER. NO. 85-518,308, FILED 1-17-2012.

KEVIN CORWIN, EXAMINING ATTORNEY



*David J. Kyfos*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***  
**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***  
**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

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**Mark:** CAPTAIN'S ORDERS!

CAPTAIN'S ORDERS!

<b>US Serial Number:</b> 85518308	<b>Application Filing Date:</b> Jan. 17, 2012
<b>US Registration Number:</b> 4281706	<b>Registration Date:</b> Jan. 29, 2013
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> Registered. The registration date is used to determine when post-registration maintenance documents are due.	
<b>Status Date:</b> Jan. 29, 2013	
<b>Publication Date:</b> Nov. 13, 2012	

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## Mark Information

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**Mark Literal Elements:** CAPTAIN'S ORDERS!  
**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

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## Related Properties Information

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**Claimed Ownership of US Registrations:** 3050890

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

<b>For:</b> Alcoholic beverages except beers	
<b>International Class(es):</b> 033 - Primary Class	<b>U.S Class(es):</b> 047, 049
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> Jan. 2004	<b>Use in Commerce:</b> Jan. 2004

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## Basis Information (Case Level)

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<b>Filed Use:</b> Yes	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

---

## Current Owner(s) Information

---

<b>Owner Name:</b> Diageo North America, Inc.	
<b>Owner Address:</b> 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
<b>Legal Entity Type:</b> CORPORATION	<b>State or Country Where Organized:</b> CONNECTICUT

---

## Attorney/Correspondence Information

---

---

### Attorney of Record

**Attorney Name:** Nicole D'Amato

Attorney Primary Email [trademarks@diageo.com](mailto:trademarks@diageo.com)  
Address:

Attorney Email No  
Authorized:

#### Correspondent

**Correspondent Name/Address:** NICOLE D'AMATO  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail Yes  
Authorized:**

#### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Jan. 29, 2013	REGISTERED-PRINCIPAL REGISTER	
Nov. 13, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Nov. 13, 2012	PUBLISHED FOR OPPOSITION	
Oct. 24, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Oct. 08, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	73787
Oct. 03, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Oct. 03, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	73787
Oct. 03, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	73787
Sep. 20, 2012	ASSIGNED TO LIE	73787
Sep. 19, 2012	ASSIGNED TO EXAMINER	82417
Sep. 11, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Apr. 26, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Apr. 26, 2012	NON-FINAL ACTION E-MAILED	6325
Apr. 26, 2012	NON-FINAL ACTION WRITTEN	82434
Apr. 19, 2012	ASSIGNED TO EXAMINER	82434
Jan. 23, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Jan. 20, 2012	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

#### TM Staff Information - None

##### File Location

**Current Location:** PUBLICATION AND ISSUE SECTION

**Date in Location:** Jan. 29, 2013

## Proceedings

#### Summary

**Number of Proceedings:** 1

#### Type of Proceeding: Opposition

**Proceeding Number:** [91221751](#)

**Filing Date:** Apr 29, 2015

**Status:** Pending

**Status Date:** Apr 29, 2015

**Interlocutory Attorney:** YONG OH (RICHARD) KIM

#### Defendant

**Name:** Captain William G. MacDonald

**Correspondent Address:** JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

**Correspondent e-mail:** [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

#### Associated marks

Mark	Application Status	Serial Number	Registration Number
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CAPTAIN W.G. MACDONALD'S		Opposition Pending	<a href="#">86354984</a>	
Plaintiff(s)				
Name: Diageo North America, Inc.				
Correspondent Address: Brian P. O'Donnell Kilpatrick Townsend & Stockton LLP 1400 Wewatta Street, Suite 600 Denver CO , 80202 UNITED STATES				
Correspondent e-mail: <a href="mailto:denverteas@kilpatricktownsend.com">denverteas@kilpatricktownsend.com</a> , <a href="mailto:bodonnell@kilpatricktownsend.com">bodonnell@kilpatricktownsend.com</a> , <a href="mailto:tdavis@kilpatricktownsend.com">tdavis@kilpatricktownsend.com</a>				
Associated marks				
Mark		Application Status	Serial Number	Registration Number
CAPTAIN MORGAN		Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN		Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671		Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN		Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN		Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!		Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO		Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK		Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK		Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY		Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>
Prosecution History				
Entry Number	History Text	Date	Due Date	
1	FILED AND FEE	Apr 29, 2015		
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015	
3	PENDING, INSTITUTED	Apr 29, 2015		

**Int. Cl.: 33**

**Prior U.S. Cls.: 47 and 49**

**United States Patent and Trademark Office**

**Reg. No. 3,435,812**

**Registered May 27, 2008**

**TRADEMARK  
PRINCIPAL REGISTER**

**CAPTAIN MORGAN TATTOO**

DIAGEO NORTH AMERICA, INC. (CONNECTI-  
CUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: DISTILLED SPIRITS, IN CLASS 33 (U.S. CLS.  
47 AND 49).

FIRST USE 6-0-2004; IN COMMERCE 6-0-2004.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 972,985, 3,032,300 AND  
OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-  
TURE(S) SHOWN IN THE MARK DOES NOT IDEN-  
TIFY A PARTICULAR LIVING INDIVIDUAL.

SER. NO. 77-310,869, FILED 10-23-2007.

RON FAIRBANKS, EXAMINING ATTORNEY

**Generated on:** This page was generated by TSDR on 2015-06-15 15:27:52 EDT

**Mark:** CAPTAIN MORGAN TATTOO

CAPTAIN MORGAN TATTOO

<b>US Serial Number:</b> 77310869	<b>Application Filing Date:</b> Oct. 23, 2007
<b>US Registration Number:</b> 3435812	<b>Registration Date:</b> May 27, 2008
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> A Sections 8 and 15 combined declaration has been accepted and acknowledged.	
<b>Status Date:</b> Mar. 17, 2014	
<b>Publication Date:</b> Mar. 11, 2008	

## Mark Information

**Mark Literal Elements:** CAPTAIN MORGAN TATTOO

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

**Name Portrait Consent:** The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

## Related Properties Information

**Claimed Ownership of US Registrations:** 0972985, 2975653, 3032300 and others

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

<b>For:</b> Distilled Spirits	
<b>International Class(es):</b> 033 - Primary Class	<b>U.S Class(es):</b> 047, 049
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> Jun. 2004	<b>Use in Commerce:</b> Jun. 2004

## Basis Information (Case Level)

<b>Filed Use:</b> Yes	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

<b>Owner Name:</b> Diageo North America, Inc.	
<b>Owner Address:</b> 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
<b>Legal Entity Type:</b> CORPORATION	<b>State or Country Where Organized:</b> CONNECTICUT

## Attorney/Correspondence Information

**Attorney of Record - None**

Correspondent			
<b>Correspondent Name/Address:</b> NICOLE D. D'AMATO Diageo North America, Inc. 801 Main Avenue Norwalk, CONNECTICUT 06851-1127 UNITED STATES			
<b>Phone:</b> (203) 229-2100			
<b>Correspondent e-mail:</b> <a href="mailto:diageodocketing@ashurst.com">diageodocketing@ashurst.com</a>		<b>Correspondent e-mail Authorized:</b> Yes	
Domestic Representative - Not Found			
Prosecution History			
Date	Description	Proceeding Number	
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED		
Mar. 17, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED		
Mar. 17, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	73376	
Feb. 25, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	73376	
Mar. 17, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	73376	
Feb. 25, 2014	TEAS SECTION 8 & 15 RECEIVED		
Feb. 25, 2014	TEAS CHANGE OF CORRESPONDENCE RECEIVED		
May 27, 2008	REGISTERED-PRINCIPAL REGISTER		
Mar. 11, 2008	PUBLISHED FOR OPPOSITION		
Feb. 20, 2008	NOTICE OF PUBLICATION		
Feb. 06, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	67287	
Feb. 06, 2008	ASSIGNED TO LIE	67287	
Dec. 29, 2007	APPROVED FOR PUB - PRINCIPAL REGISTER		
Dec. 28, 2007	ASSIGNED TO EXAMINER	76463	
Oct. 26, 2007	NEW APPLICATION ENTERED IN TRAM		
Maintenance Filings or Post Registration Information			
<b>Affidavit of Continued Use:</b> Section 8 - Accepted			
<b>Affidavit of Incontestability:</b> Section 15 - Accepted			
TM Staff and Location Information			
TM Staff Information - None			
File Location			
<b>Current Location:</b> TMO LAW OFFICE 117		<b>Date in Location:</b> Mar. 17, 2014	
Proceedings			
Summary			
<b>Number of Proceedings:</b> 1			
Type of Proceeding: Opposition			
<b>Proceeding Number:</b> <a href="#">91221751</a>		<b>Filing Date:</b> Apr 29, 2015	
<b>Status:</b> Pending		<b>Status Date:</b> Apr 29, 2015	
<b>Interlocutory Attorney:</b> YONG OH (RICHARD) KIM			
Defendant			
<b>Name:</b> Captain William G. MacDonald			
<b>Correspondent Address:</b> JOHN S. EGBERT Egbert Law Offices PLLC 1314 Texas St Fl 21 Houston TX , 77002-6577			
<b>Correspondent e-mail:</b> <a href="mailto:mail@egbertlawoffices.com">mail@egbertlawoffices.com</a>			
Associated marks			
		Serial	Registration

Mark	Application Status	Number	Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	
<b>Plaintiff(s)</b>			

**Name:** Diageo North America, Inc.

**Correspondent Address:** Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

**Correspondent e-mail:** [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

<b>Associated marks</b>			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

<b>Prosecution History</b>			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

# United States of America

United States Patent and Trademark Office

## CAPTAIN MORGAN BLACK

**Reg. No. 4,290,286**

**Registered Feb. 12, 2013**

**Int. Cl.: 33**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 2-15-2012; IN COMMERCE 2-15-2012.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 972,985, 3,509,465, AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BLACK", APART FROM THE MARK AS SHOWN.

SN 85-609,416, FILED 4-26-2012.

CHRISTINA SOBRAL, EXAMINING ATTORNEY



*Lisa Street Lee*

Acting Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

**First Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

**Second Filing Deadline:** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

**Generated on:** This page was generated by TSDR on 2015-06-15 15:29:00 EDT

**Mark:** CAPTAIN MORGAN BLACK

CAPTAIN MORGAN BLACK

<b>US Serial Number:</b> 85609416	<b>Application Filing Date:</b> Apr. 26, 2012
<b>US Registration Number:</b> 4290286	<b>Registration Date:</b> Feb. 12, 2013
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> Registered. The registration date is used to determine when post-registration maintenance documents are due.	
<b>Status Date:</b> Feb. 12, 2013	
<b>Publication Date:</b> Oct. 02, 2012	<b>Notice of Allowance Date:</b> Nov. 27, 2012

## Mark Information

**Mark Literal Elements:** CAPTAIN MORGAN BLACK

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

**Disclaimer:** "BLACK"

## Related Properties Information

**Claimed Ownership of US Registrations:** 0972985, 2168573, 3509465 and others

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

**For:** Alcoholic beverages except beers

<b>International Class(es):</b> 033 - Primary Class	<b>U.S Class(es):</b> 047, 049
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> Feb. 15, 2012	<b>Use in Commerce:</b> Feb. 15, 2012

## Basis Information (Case Level)

<b>Filed Use:</b> No	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> Yes	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

**Owner Name:** Diageo North America, Inc.

**Owner Address:** 801 Main Avenue  
Norwalk, CONNECTICUT 06851  
UNITED STATES

**Legal Entity Type:** CORPORATION

**State or Country Where Organized:** CONNECTICUT

## Attorney/Correspondence Information

Attorney of Record

Attorney Name: Nicole D. D'Amato  
Attorney Primary Email [trademarks@diageo.com](mailto:trademarks@diageo.com)  
Address:

Docket Number: Project Fixe  
Attorney Email No  
Authorized:

#### Correspondent

Correspondent Name/Address: NICOLE D. D'AMATO  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

Phone: (203) 229-2100

Correspondent e-mail: [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

Correspondent e-mail Yes  
Authorized:

#### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Feb. 12, 2013	REGISTERED-PRINCIPAL REGISTER	
Jan. 11, 2013	NOTICE OF ACCEPTANCE OF STATEMENT OF USE E-MAILED	
Jan. 10, 2013	LAW OFFICE REGISTRATION REVIEW COMPLETED	68123
Jan. 07, 2013	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 07, 2013	STATEMENT OF USE PROCESSING COMPLETE	76538
Dec. 12, 2012	USE AMENDMENT FILED	76538
Jan. 04, 2013	CASE ASSIGNED TO INTENT TO USE PARALEGAL	76538
Dec. 12, 2012	TEAS STATEMENT OF USE RECEIVED	
Nov. 27, 2012	NOA E-MAILED - SOU REQUIRED FROM APPLICANT	
Oct. 02, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 02, 2012	PUBLISHED FOR OPPOSITION	
Sep. 12, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 30, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Aug. 29, 2012	ASSIGNED TO LIE	68123
Aug. 17, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 16, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Aug. 16, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Aug. 16, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 06, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2012	NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2012	NON-FINAL ACTION WRITTEN	83185
Aug. 06, 2012	ASSIGNED TO EXAMINER	83185
May 03, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 30, 2012	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

#### TM Staff Information - None

#### File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jan. 10, 2013

## Proceedings

#### Summary

Number of Proceedings: 1

#### Type of Proceeding: Opposition

Proceeding Number: [91221751](#)

Status: Pending

Filing Date: Apr 29, 2015

Status Date: Apr 29, 2015

Interlocutory Attorney: YONG OH (RICHARD) KIM

**Defendant**

**Name:** Captain William G. MacDonald

**Correspondent Address:** JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

**Correspondent e-mail:** [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	

**Plaintiff(s)**

**Name:** Diageo North America, Inc.

**Correspondent Address:** Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

**Correspondent e-mail:** [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

# United States of America

United States Patent and Trademark Office



**Reg. No. 4,260,826**

**Registered Dec. 18, 2012**

**Int. Cl.: 33**

**TRADEMARK**

**PRINCIPAL REGISTER**

DIAGEO NORTH AMERICA, INC. (CONNECTICUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: ALCOHOLIC BEVERAGES EXCEPT BEERS, IN CLASS 33 (U.S. CLS. 47 AND 49).

FIRST USE 2-15-2012; IN COMMERCE 2-15-2012.

OWNER OF U.S. REG. NOS. 972,985, 3,509,465 AND OTHERS.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BLACK", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE STYLIZED WORDS "CAPTAIN MORGAN" BELOW WHICH IS THE WORD "BLACK" IN A STYLIZED FONT SUPERIMPOSED OVER A SWIRL DESIGN.

SER. NO. 85-602,310, FILED 4-19-2012.

CHRISTINA SOBRAL, EXAMINING ATTORNEY



*David J. Kyffers*

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL  
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE  
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

**Requirements in the First Ten Years\***

**What and When to File:**

***First Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

***Second Filing Deadline:*** You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.\*  
*See* 15 U.S.C. §1059.

**Requirements in Successive Ten-Year Periods\***

**What and When to File:**

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.\*

**Grace Period Filings\***

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or  
reminder of these filing requirements.**

**\*ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

**NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.**

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**Mark:** CAPTAIN MORGAN BLACK



**US Serial Number:** 85602310

**Application Filing Date:** Apr. 19, 2012

**US Registration Number:** 4260826

**Registration Date:** Dec. 18, 2012

**Filed as TEAS Plus:** Yes

**Currently TEAS Plus:** Yes

**Register:** Principal

**Mark Type:** Trademark

**Status:** Registered. The registration date is used to determine when post-registration maintenance documents are due.

**Status Date:** Dec. 18, 2012

**Publication Date:** Oct. 02, 2012

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## Mark Information

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**Mark Literal Elements:** CAPTAIN MORGAN BLACK

**Standard Character Claim:** No

**Mark Drawing Type:** 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)

**Description of Mark:** The mark consists of the stylized words "CAPTAIN MORGAN" below which is the word "BLACK" in a stylized font superimposed over a swirl design.

**Color(s) Claimed:** Color is not claimed as a feature of the mark.

**Disclaimer:** "BLACK"

**Design Search Code(s):** 26.17.09 - Bands, curved; Lines, curved; Curved line(s), band(s) or bar(s); Bars, curved

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## Related Properties Information

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**Claimed Ownership of US Registrations:** 0972985, 2168573, 3509465 and others

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## Goods and Services

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**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis (()) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "\*" identify additional (new) wording in the goods/services.

**For:** Alcoholic beverages except beers

**International Class(es):** 033 - Primary Class

**U.S Class(es):** 047, 049

**Class Status:** ACTIVE

**Basis:** 1(a)

**First Use:** Feb. 15, 2012

**Use in Commerce:** Feb. 15, 2012

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## Basis Information (Case Level)

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**Filed Use:** Yes

**Currently Use:** Yes

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

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## Current Owner(s) Information

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**Owner Name:** Diageo North America, Inc.

**Owner Address:** 801 Main Avenue  
Norwalk, CONNECTICUT 06851

UNITED STATES  
Legal Entity Type: CORPORATION

State or Country Where  
Organized: CONNECTICUT

## Attorney/Correspondence Information

### Attorney of Record

Attorney Name: Nicole D. D'Amato  
Attorney Primary Email Address: [trademarks@diageo.com](mailto:trademarks@diageo.com)  
Docket Number: Project Fixe  
Attorney Email Authorized: No

### Correspondent

Correspondent Name/Address: NICOLE D. D'AMATO  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES  
Phone: (203) 229-2100  
Correspondent e-mail: [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)  
Correspondent e-mail Authorized: Yes

### Domestic Representative - Not Found

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Dec. 18, 2012	REGISTERED-PRINCIPAL REGISTER	
Oct. 02, 2012	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Oct. 02, 2012	PUBLISHED FOR OPPOSITION	
Sep. 12, 2012	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Aug. 30, 2012	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Aug. 29, 2012	ASSIGNED TO LIE	68123
Aug. 17, 2012	APPROVED FOR PUB - PRINCIPAL REGISTER	
Aug. 16, 2012	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Aug. 16, 2012	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Aug. 16, 2012	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Aug. 06, 2012	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2012	NON-FINAL ACTION E-MAILED	6325
Aug. 06, 2012	NON-FINAL ACTION WRITTEN	83185
Aug. 06, 2012	ASSIGNED TO EXAMINER	83185
Apr. 27, 2012	NOTICE OF DESIGN SEARCH CODE MAILED	
Apr. 26, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Apr. 23, 2012	NEW APPLICATION ENTERED IN TRAM	

## TM Staff and Location Information

### TM Staff Information - None File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Dec. 18, 2012

## Proceedings

### Summary

Number of Proceedings: 1

### Type of Proceeding: Opposition

Proceeding Number: [91221751](#)

Filing Date: Apr 29, 2015

Status: Pending

Status Date: Apr 29, 2015

Interlocutory Attorney: YONG OH (RICHARD) KIM

### Defendant

**Name:** Captain William G. MacDonald

**Correspondent Address:** JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

**Correspondent e-mail:** [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	
Plaintiff(s)			

**Name:** Diageo North America, Inc.

**Correspondent Address:** Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

**Correspondent e-mail:** [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bdonnell@kilpatricktownsend.com](mailto:bdonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

Associated marks			
Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

Prosecution History			
Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	

**Int. Cl.: 33**

**Prior U.S. Cls.: 47 and 49**

**United States Patent and Trademark Office**

**Reg. No. 3,603,578**

**Registered Apr. 7, 2009**

**TRADEMARK  
PRINCIPAL REGISTER**

**CAPTAIN MORGAN PARROT BAY**

DIAGEO NORTH AMERICA, INC. (CONNECTI-  
CUT CORPORATION)  
801 MAIN AVENUE  
NORWALK, CT 06851

FOR: DISTILLED SPIRITS, IN CLASS 33 (U.S. CLS.  
47 AND 49).

FIRST USE 8-6-2008; IN COMMERCE 8-6-2008.

THE MARK CONSISTS OF STANDARD CHAR-  
ACTERS WITHOUT CLAIM TO ANY PARTICULAR  
FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,168,573, 3,262,926,  
AND OTHERS.

THE NAME(S), PORTRAIT(S), AND/OR SIGNA-  
TURE(S) SHOWN IN THE MARK DOES NOT IDEN-  
TIFY A PARTICULAR LIVING INDIVIDUAL.

SN 77-310,152, FILED 10-22-2007.

RON FAIRBANKS, EXAMINING ATTORNEY

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**Mark:** CAPTAIN MORGAN PARROT BAY

CAPTAIN MORGAN PARROT BAY

<b>US Serial Number:</b> 77310152	<b>Application Filing Date:</b> Oct. 22, 2007
<b>US Registration Number:</b> 3603578	<b>Registration Date:</b> Apr. 07, 2009
<b>Filed as TEAS Plus:</b> Yes	<b>Currently TEAS Plus:</b> Yes
<b>Register:</b> Principal	
<b>Mark Type:</b> Trademark	
<b>Status:</b> A Sections 8 and 15 combined declaration has been accepted and acknowledged.	
<b>Status Date:</b> Apr. 21, 2014	
<b>Publication Date:</b> Apr. 29, 2008	<b>Notice of Allowance Date:</b> Jul. 22, 2008

## Mark Information

**Mark Literal Elements:** CAPTAIN MORGAN PARROT BAY

**Standard Character Claim:** Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

**Mark Drawing Type:** 4 - STANDARD CHARACTER MARK

**Name Portrait Consent:** The name(s), portrait(s), and/or signature(s) shown in the mark does not identify a particular living individual.

## Related Properties Information

**Claimed Ownership of US Registrations:** 2168573, 2570141, 3262926 and others

## Goods and Services

**Note:** The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks \*..\* identify additional (new) wording in the goods/services.

<b>For:</b> Distilled Spirits	
<b>International Class(es):</b> 033 - Primary Class	<b>U.S Class(es):</b> 047, 049
<b>Class Status:</b> ACTIVE	
<b>Basis:</b> 1(a)	
<b>First Use:</b> Aug. 06, 2008	<b>Use in Commerce:</b> Aug. 06, 2008

## Basis Information (Case Level)

<b>Filed Use:</b> No	<b>Currently Use:</b> Yes	<b>Amended Use:</b> No
<b>Filed ITU:</b> Yes	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> No	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> No	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

<b>Owner Name:</b> Diageo North America, Inc.	
<b>Owner Address:</b> 801 Main Avenue Norwalk, CONNECTICUT 06851 UNITED STATES	
<b>Legal Entity Type:</b> CORPORATION	<b>State or Country Where Organized:</b> CONNECTICUT

## Attorney/Correspondence Information

Attorney of Record

Attorney Name: Jennifer Hamilton

Docket Number: 81052442

Attorney Primary Email [trademarks@diageo.com](mailto:trademarks@diageo.com)  
Address:

Attorney Email Yes  
Authorized:

**Correspondent**

**Correspondent Name/Address:** Jennifer Hamilton  
Diageo North America, Inc.  
801 Main Avenue  
Norwalk, CONNECTICUT 06851-1127  
UNITED STATES

**Phone:** (203) 229-2100

**Correspondent e-mail:** [diageodocketing@ashurst.com](mailto:diageodocketing@ashurst.com)

**Correspondent e-mail** Yes  
**Authorized:**

**Domestic Representative - Not Found**

## Prosecution History

Date	Description	Proceeding Number
Mar. 31, 2015	TEAS CHANGE OF CORRESPONDENCE RECEIVED	
Apr. 21, 2014	NOTICE OF ACCEPTANCE OF SEC. 8 & 15 - E-MAILED	
Apr. 21, 2014	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	77315
Apr. 07, 2014	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	77315
Apr. 21, 2014	CASE ASSIGNED TO POST REGISTRATION PARALEGAL	77315
Apr. 07, 2014	TEAS SECTION 8 & 15 RECEIVED	
Apr. 07, 2009	REGISTERED-PRINCIPAL REGISTER	
Feb. 27, 2009	LAW OFFICE REGISTRATION REVIEW COMPLETED	77312
Feb. 26, 2009	ALLOWED PRINCIPAL REGISTER - SOU ACCEPTED	
Jan. 29, 2009	STATEMENT OF USE PROCESSING COMPLETE	66230
Jan. 09, 2009	USE AMENDMENT FILED	66230
Jan. 29, 2009	CASE ASSIGNED TO INTENT TO USE PARALEGAL	66230
Jan. 09, 2009	TEAS STATEMENT OF USE RECEIVED	
Jul. 22, 2008	NOA MAILED - SOU REQUIRED FROM APPLICANT	
Apr. 29, 2008	PUBLISHED FOR OPPOSITION	
Apr. 09, 2008	NOTICE OF PUBLICATION	
Mar. 24, 2008	LAW OFFICE PUBLICATION REVIEW COMPLETED	77312
Mar. 24, 2008	ASSIGNED TO LIE	77312
Mar. 07, 2008	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 05, 2008	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 05, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 05, 2008	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Dec. 30, 2007	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Dec. 30, 2007	NON-FINAL ACTION E-MAILED	6325
Dec. 30, 2007	NON-FINAL ACTION WRITTEN	76463
Dec. 22, 2007	ASSIGNED TO EXAMINER	76463
Oct. 25, 2007	NEW APPLICATION ENTERED IN TRAM	

## Maintenance Filings or Post Registration Information

**Affidavit of Continued Use:** Section 8 - Accepted

**Affidavit of Incontestability:** Section 15 - Accepted

## TM Staff and Location Information

**TM Staff Information - None**

**File Location**

**Current Location:** TMO LAW OFFICE 117

**Date in Location:** Apr. 21, 2014

# Proceedings

## Summary

Number of Proceedings: 1

### Type of Proceeding: Opposition

Proceeding Number: [91221751](#)

Filing Date: Apr 29, 2015

Status: Pending

Status Date: Apr 29, 2015

Interlocutory Attorney: YONG OH (RICHARD) KIM

### Defendant

Name: Captain William G. MacDonald

Correspondent Address: JOHN S. EGBERT  
Egbert Law Offices PLLC  
1314 Texas St Fl 21  
Houston TX , 77002-6577

Correspondent e-mail: [mail@egbertlawoffices.com](mailto:mail@egbertlawoffices.com)

### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN W.G. MACDONALD'S	Opposition Pending	<a href="#">86354984</a>	

### Plaintiff(s)

Name: Diageo North America, Inc.

Correspondent Address: Brian P. O'Donnell  
Kilpatrick Townsend & Stockton LLP  
1400 Wewatta Street, Suite 600  
Denver CO , 80202  
UNITED STATES

Correspondent e-mail: [denverteas@kilpatricktownsend.com](mailto:denverteas@kilpatricktownsend.com) , [bodonnell@kilpatricktownsend.com](mailto:bodonnell@kilpatricktownsend.com) , [tdavis@kilpatricktownsend.com](mailto:tdavis@kilpatricktownsend.com)

### Associated marks

Mark	Application Status	Serial Number	Registration Number
CAPTAIN MORGAN	Renewed	<a href="#">72417450</a>	<a href="#">972985</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77303060</a>	<a href="#">3466371</a>
CAPTAIN MORGAN 1671	Registered	<a href="#">86249606</a>	<a href="#">4705270</a>
CAPTAIN MORGAN	Section 8 and 15 - Accepted and Acknowledged	<a href="#">78410544</a>	<a href="#">3159948</a>
CAPTAIN MORGAN	Registered	<a href="#">85039011</a>	<a href="#">4126073</a>
CAPTAIN'S ORDERS!	Registered	<a href="#">85518308</a>	<a href="#">4281706</a>
CAPTAIN MORGAN TATTOO	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310869</a>	<a href="#">3435812</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85609416</a>	<a href="#">4290286</a>
CAPTAIN MORGAN BLACK	Registered	<a href="#">85602310</a>	<a href="#">4260826</a>
CAPTAIN MORGAN PARROT BAY	Section 8 and 15 - Accepted and Acknowledged	<a href="#">77310152</a>	<a href="#">3603578</a>

### Prosecution History

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Apr 29, 2015	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Apr 29, 2015	Jun 08, 2015
3	PENDING, INSTITUTED	Apr 29, 2015	